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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/900,254	07/25/1997	PETER PFEUFFER	22750/350	7919

26646 7590 05/16/2006

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/900,254	Applicant(s) PFEUFFER, PETER	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is indefinite, because the limitations “portion” and the “the remainder” do not have a positive antecedent basis. Moreover, while this claim requires “the non woven fabric is formed without inhomogeneties”, the added limitation reads the “portion” being less bonded than “the remainder” of the web. On the one hand, if it is Applicant’s intention for this added limitation to embrace having the “portion” to be less bonded than “the remainder” of the web, then this would be inconsistent with claim requirement that no “inhomogeneties” is formed to a finished web. On the other hand, if it is Applicant’s intention for this added limitation to only embrace having bonding strength of the “portion” and “the remainder” of the web to be equal, then how would this added limitation further define/limit claim 1. For the purpose of examining the added limitation, the added limitation is assumed to require having an equal bonding strength over a cross-section of a non-woven fabric. This added limitation however has implicitly been considered in the prior office actions, since claim 1 already requires forming a

nonwoven fabric "without inhomogeneities over the cross section of the non woven fabric".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (US 4,496,583) in view of Narou et al (US 4,876,007) and Norton (US 2,862,542) and further in view of (Thornton (US 4,772,443), Frank (US 5,492,580), DE 4024053 A1, and Gosden (US 3,616,167) for reasons of record set forth in an Examiner's Answer dated 10-04-06, and for reasons set forth hereinafter.

As for an added limitation in this claim regarding the bonding strength of non-woven fabric, such is taken to naturally flow from the modified process of Yamamoto et al in view of the similarity of the production processes between the presently claimed process and a modified process of Yamamoto et al. Also see Examiner's response to Counsel's argument for details.

Note: Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art**

Art Unit: 1733

products.” In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

Response to Arguments

5. Applicant's arguments filed on 04-20-06 have been fully considered but they are not persuasive.

On page 3 to page 6, while Counsel conceded that Yamamoto et al discloses forming a non-woven web from a uniformly dispersed fibers, Counsel nevertheless argued that, “[t]he relative strength of the bonds of the non woven fabric are not described in Yamamoto et al. as a role in whether the resultant filter material is even, e.g. “homogenous.”” (bond-face and quotation in original). While it is true that Yamamoto et al does not explicitly disclose the relative bonding strength of a finished non-woven web, nonetheless, a finished corrugated/pleated non-woven filter in a modified process of Yamamoto et al is reasonably expected to have a uniform bonding strength in view of the similarity of the production processes between the modified process of Yamamoto et al and the claimed process.

The modified process of Yamamoto et al	versus	The claimed invention
a) uniform blend of undrawn and drawn synthetic fibers		undrawn and drawn synthetic fibers

- | | |
|-------------------------------------|-------------------------------------|
| b) preheated web | preheated web |
| c) unheated profiled calendar rolls | unheated profiled
calendar rolls |
| d) no flat bonding is used | no flat bonding is used |

There is simply nothing in the claimed invention or even in the original disclosure as a whole, which provides any indication that the present invention is performing any special or unique process operation(s), which enables one to form a uniformly bonded web "without inhomogeneities over the cross section of the non woven fabric", which is/are different from the modified process of Yamamoto et al. For this reason, it would be reasonable to expect that a uniform bonding strength "over its cross-section" of the web would intrinsically be formed in the modified process of Yamamoto et al.

As for the case laws cited by Counsel, Examiner agrees with the conclusions of the court's opinions. However, contrary to Counsel's assertion, Examiner has provided sufficient reason/motivation on why one in the art would have modified the process of Yamamoto et al to arrive the presently claimed invention as evidence from the fact that BPAI has affirmed twice the basis of Examiner's rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571)

Art Unit: 1733

272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
05-12-06